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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/406,666    09/27/99    PALINKAS

R    D-6371

EXAMINER

PM82/0601

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WORLD HEADQUARTERS  
MIDDLEBURY CT 06749

PETRAVICK, M

ART UNIT

PAPER NUMBER

3671  
DATE MAILED:

06/01/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/406,666

Applicant(s)

PALINKAS, RICHARD L.

Examiner

Meredith C Petravick

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilby 3,667,797.

Kilby discloses the claimed device including:

- a pad (10)
- a tree shaking apparatus (12)
- a pair of opposing sections (outer ends of 10 next to 52)
- a bore (for bolts 57)
- a mounting member (57)
- a resilient polymeric web (middle portion of 10)
- two apertures (52)

However, Kilby discloses horizontal bores for the mounting members instead of longitudinal bores. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bores longitudinal instead of horizontal, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Art Unit: 3671

3. Claims 1-2, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilby in view of SU 1,329,666.

Kilby discloses the claimed device including:

- a pad (10)
- a tree shaking apparatus (12)
- a pair of opposing sections (outer ends of 10 next to 52)
- a bore (for bolts 57)
- a mounting member (57)
- a resilient polymeric web (middle portion of 10)
- two apertures (52)

Kilby also states that any suitable means may be used to mount the pad. (column 3, lines 43-45)

However, Kilby discloses horizontal bores for the mounting members instead of longitudinal bores.

Like Kilby, SU 1,329,666 discloses a pad for a tree shaker. SU 1,329,666 uses longitudinal bores and mounting members. (see figure)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to mount the pad of Kilby longitudinally as in SU 1,329,666, as an alternate suitable mounting means.

4. Claim 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilby in view of SU 1,329,666 as applied to claim 1 and further in view of Favor, 3,771,301.

Art Unit: 3671

The combination discloses the claimed device and suggests that pads should be made of resilient material. (column 1, line 44 - 47) However, the combination does not disclose the exact material.

Like the combination, Favor discloses a pad for the jaws of a tree shaker. The pad is made of polyurethane, which is an elastomer material. (column 8, lines 65-67)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pad of the combination from polyurethane as in Favor, as one type of resilient material used in a pad.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kilby in view of SU 1,329,666 as applied to claim 1 and further in view of Korthuis 5,666,796.

The combination discloses the claimed device and suggests that pads should be made of resilient material. (column 1, line 44 - 47) However, the combination does not disclose the exact material.

Like the combination, Korthuis discloses a machine for harvesting fruit including a tree-engaging portion. Korthuis provides a resilient polyethylene pad around the beaters of the machine. (column 2, lines 44-46) This pad protects the beaters.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pad of the combination from polyethylene as in Korthuis, as one type of known resilient material used as a pad for engaging trees.

***Response to Arguments***

6. Applicant's arguments filed 3/15/01 have been fully considered but they are not persuasive.

Independent claims 1 and 7 are rejected under 35 U.S.C. 103(a) based on Kilby. Dependent claims 2-6 are rejected under 35 U.S.C. 103(a) based on Kilby and/or secondary references.

In the amendment filed 3/15/01, applicant argues that Kilby fails to disclose a resilient web that bends to conform to the curvature of the tree, but instead discloses a resilient web that compresses to conform to the curvature of the tree. Applicant states, "The resilient web of the present invention means that the web bends to conform to the curvature of the tree, not the web can be compressed such that it conforms to the curvature of the tree."

In response to applicant's argument that Kilby fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a resilient web which bends to conform to the curvature of a tree) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's claims only recite "a resilient polymeric web" and do not limit the claim to a resilient web that bends instead of compresses.

Further, in the specification applicant fails to define "a resilient web." The specification only states:

1) "A web of resilient polymeric material extends between the end sections and during operation, engages the trunk of the tree to be shaken." (page 2, lines 16-17)

Art Unit: 3671

2) "A resilient web 24 extends between the end sections 21 and is made from a suitable material, such as, but not limited to polyurethane." (page 3, lines 18-20),

The specification fails to limit the definition of "a resilient web" to means the web that only bends around a tree and not compresses around a tree. Therefore, the limitation "a resilient web" is given the broadest reasonable meaning and the resilient web of Kilby meets the limitations of the claims.

For the reasons stated above, claims 1-7 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kilby in view of secondary references.

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

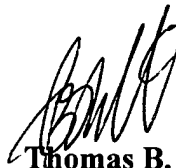
Art Unit: 3671

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meredith Petravick whose telephone number is 703-305-0047.

The examiner can normally be reached on Monday-Thursday from 7:00 a.m. – 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at 703-308-3870.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is 703-305-1113. The fax number for this Group is 703-305-3597.



**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group Art Unit 3671**

MCP  
May 31, 2001